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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/484,306  | 01/18/2000  | Yoshio Kondo         | 450100-4490.5       | 9534             |
| 20999   | 7590        | 12/19/2003           | EXAMINER            |                  |
| FROMMER LAWRENCE & HAUG<br>745 FIFTH AVENUE- 10TH FL.<br>NEW YORK, NY 10151 |             |                      | WALSH, DANIEL I     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2876                |                  |

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/484,306

Applicant(s)

KONDO ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-17 and 41-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-17 and 50-56 is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 9, 41-43, 48 and 49 is/are rejected.
- 7) ☒ Claim(s) 4-7 and 44-47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1. ☒ Certified copies of the priority documents have been received.
  - 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Receipt is acknowledged of the Amendment received 11 August 2003.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3, 8, 41-43, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al. (US 5,388,248), further in view of Matsushita (US 4,982,378) and Yamamoto (US 4,737,602).

Robinson et al. teaches a memory card for storing data written thereto from an external device through card 110. Robinson et al. teaches the card has a rectangular card body having first and second substantially rectangular surfaces and edges between the surfaces (FIG. 1).

Robinson et al. teaches terminals provided in the vicinity of one of the edges between the surfaces for inputting data from or outputting data to the external device (FIG. 2). Robinson et al. teaches a storage device (EEPROMs 80-99; see FIG. 4, for example) in the card body for storing data inputted from the terminals. Robinson et al. teaches an electric switch 116 operable to a state to prevent the data stored in the storage device from being erased. Robinson et al. teaches a control circuit 150 disposed in the card body and electrically connected between the terminals and the storage device for writing data from an external device to the storage device, for reading out stored data to the terminals from the storage device, and for supplying to the terminals a status signal representing the state of the switch. Robinson et al. teaches the switch is electrically connected to the control circuit (FIG. 6). It is well known in the art that the host apparatus/computer 101 for example, includes terminals to read signals from the memory card terminals. Further, as Robinson et al. teaches that the memory card outputs a status of the write protection switch to the computer (col 5, lines 47+). Re claims 2 and 42, Robinson et al. teaches the switch has a slide member located in a recess (FIG. 1). Further, it is well known and conventional that write protection switches have a slide member located in a recess (floppy discs, Yamamoto, Inoue et al.) for ease of manipulation. Re claims 3 and 43, the slide member of Robinson, and the slide members well known in the art, are reciprocally movable in a side to side manner toward one and away from the other of longitudinal ones of the edges, the state of the switch being determined by the position thereof. Re claims 8 and 48, since the switch is operated by physically sliding the switch it is understood that it remains operable when used with an external device, especially as the teachings of Robinson et al. include embodiments where the card is not easily removable from the external device, thus suggesting the switch can be used

while the card is connected to the device (col 5, lines 48+).

Robinson et al. fails to teach that the terminals and electric switch are located on a first substantially rectangular surface of the card, and that the switch is disposed proximate the terminals.

It is well known and conventional to have terminals/contacts of a memory card provided on a rectangular surface of a memory card. Specifically, Matsushita teaches such limitations through FIG. 1.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to have terminals on the surface.

One would have been motivated to do this to create a more robust connection means compared to pins that is well known and conventional in the art.

Though Robinson et al./Matsushita teach an electrical switch, they fail to teach the switch is disposed on the surface of the card proximate the terminals.

It is well known and conventional that switches can be located on card ends, tops, etc. Specifically, Yamamoto teaches a switch on the top of the memory card (see FIG. 1 and col 1, lines 14+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Robinson et al./Matsushita with those of Yamamoto.

One would have been motivated to do this to have a switch that is more convenient and easier for the user to use, by providing it on a surface of the card, which has more surface area, thus making switching the switch easier to use.

Though Robinson/Matsushita/Yamamoto fail to teach the switch being disposed

proximate the terminals, it would have been an obvious matter of design choice to relocate a switch to different locations on the card, since it appears the invention would perform equally well with the switch located proximate/on not proximate the terminals and relocating the switches does not serve any functional purpose not taught by the switch of the prior art, or what is well known in the art.

3. Claims 9 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al./Matsushita/Yamamoto, as applied to claim 1 above, and further in view of Kokubu (US 5,710,421, cited in the prior Office Action).

The teachings of Robinson et al./Matsushita/Yamamoto are silent to serial transmission with the control circuit.

It is well known and conventional to transmit data serially in a card system, and Kokubu teaches such data transmission (col 4, lines 40+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Robinson et al./Matsushita/Yamamoto with those of Kokubu.

One would have been motivated to do this in order to transmit data in a reliable and accurate means, which is conventional in the art, and therefore an obvious expedient.

***Allowable Subject Matter***

4. Claims 10, 11, 13-17, and 50-56 are allowed.

5. Claims 4-7 and 44-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The prior art of record is silent to the control circuit being responsive to a read status instruction signal from the external device to supply the status signal to the terminals, and that the control circuit is receives from the terminals of the host apparatus, a status signal representing the state of the switch on the memory card.

#### ***Response to Amendments***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Takeda (US 4,532,419), White (US 4,630,201), Hasegawa et al. (US 4,780,604), Fushimoto (US 4,652,976), and Utsumi (US 6,501,163).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (703) 305-1001. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.



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Art Unit: 2876

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D. Walsh

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DW

12/10/03

  
KARL D. FRECH  
PRIMARY EXAMINER